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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,037	07/10/2001	Peter R. Bloeme	14081/255319	7782

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EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,037

Applicant(s)

BLOEME ET AL.

Examiner

Faye Francis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the proper antecedent basis should be provided in the specification for the requirement in claim 1 that a first and a second gripping surfaces formed of irregular surface and for the requirement in claim 10 that flight plate and transition area having a thickness greater than 0.90 inches.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is finally rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New matter.

The specification as originally filed does not provide support for the teaching of a first and a second gripping surface formed of irregular surfaces as now recited in claim

1. Accordingly this limitation is considered to be New Matter. Applicant is required to cancel the new matter in the response to this office action.

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1. The specification as originally filed does not provide support for the teaching of a first and a second gripping surface formed of irregular surfaces as now recited in claim 1. Accordingly this limitation is considered to be New Matter. Applicant is required to cancel the new matter in the response to this office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 are finally rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitchell et al, hereinafter Mitchell.

Mitchell discloses in Fig 2, a disc for being thrown in the air, comprising: an annular rim 12 formed along an outer periphery of the disc, a flight plate [annular section 10] formed in a central portion of the disc, a transition are [curvature 17] joining the annular rim to the flight plate and presenting a sloped surface between the annular rim and the flight plate, a first gripping surface formed on an upper side of the disc, a second gripping surface formed on a lower side of the disc [any area on the top or on bottom surface of the disc can be considered as the first and second gripping surfaces respectively] wherein the first and second gripping surfaces provide frictional surfaces to a person throwing the disc as recited in claims 1 and 10. Additionally, Mitchell discloses the first and second gripping surfaces are comprised of segmented ["divided into or composed of segments or sections" according to Merrian-Webster's Collegiate Dictionary Tenth Edition] raised surfaces [Figs 3, 4, 6, 7] as recited in claims 2 and 12, the first and second gripping surfaces are comprised of staggered raised surfaces as recited in claims 3 and 13.

Should Mitchell be later deemed not to meet claims 1 and 6 because Mitchell does not disclose that the first and second gripping surface are each formed of irregular surfaces and which are uni-directional respectively, it would have been obvious to provide the first and a second surfaces in the device of Mitchell with irregular surfaces which are uni-directional in order to give the device a different look.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell.

Mitchell discloses most of the element in these claims as stated in paragraph 5.

Mitchell does not disclose the annular rim has a thickness of 0.093 inches as recited in claim 7, the diameter of the annular rim is less than 9 inches as recited in claim 8, Additionally, Mitchell does not disclose the ratio of a height of the flight plate to a diameter of the annular rim is less than 1 to 9 as recited in claim 9.

With respect to claims 7-9, it would have been obvious to provide the disc of Mitchell in the claimed dimensions for the purpose of making the devices easier to play with.

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8. Claims 10-16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell.

Mitchell discloses most of the element in these claims as applied to claims 1-6 above but for the diameter of the annular rim is less than 9 inches and the ratio of a height of the flight plate to a diameter of the annular rim is less than 1 to 9 as recited in claim 10.

With respect to claim 10, it would have been obvious to provide the disc of Mitchell in the claimed dimensions for the purpose of making the devices easier to play with.

With respect to claims 14-16, it would have been obvious to provide the first and second surfaces in the device of Mitchell with uni-directional surfaces in order to give the device a different look.

Response to Arguments

9. Applicant's arguments filed 9/5/02 have been fully considered but they are not persuasive.

In response to applicant's argument in page 4, that the specification does provide antecedent basis for the requirement in claim 8 that diameter of the annular rim is less than 9 inches and for the requirement in claim 9 that a ratio of a height of the flight plate to a diameter of the annular rim is less than 1 to 9" is hereby withdrawn. However, in response to applicant's argument regarding flight plate and transition area having a thickness greater than 0.90 inches, the applicant's arguments are not persuasive and therefore the rejection stands.

In response to applicant's argument on page 5 regarding rejections under 35 U.S.C. 112 2nd paragraph, the rejections are hereby withdrawn on all grounds.

In response to applicant's argument in page 8, the modified device of Mitchell would make obvious a disc having irregular surfaces for gripping by a person. Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). In this case, the artisan would have been motivated to provide the first and second surfaces in the device of Mitchell with irregular surfaces, which are uni-directional in order to give the device a different look

In response to applicant's argument on page 9 that the claimed dimensions provide a number of advantages which are not apparent to those skilled in the art, such as the disc is found to travel approximately 10 to 20 percent further than other disc when thrown under similar conditions and the dimensions of the disc allow it to fly farther than other canine discs when thrown under similar conditions. The examiner would like to point out that none of these advantages would make the claims non obvious. Additionally, all of these have not been captured by the claims that only require different dimensions from the ones disclosed in the reference.

Thus, taking into account all of the knowledge in the art as previously discussed, the real reason for the applicant's claims of non obviousness may simply be that Mitchell does not identically disclose all of the elements of the claims as amended after the first Office Action. Such reasoning is clearly improper.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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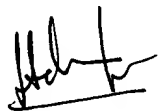
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF
November 1, 2002


Jacob K. Ackun
Primary Examiner